

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte RENATE ZYGAN-MAUS

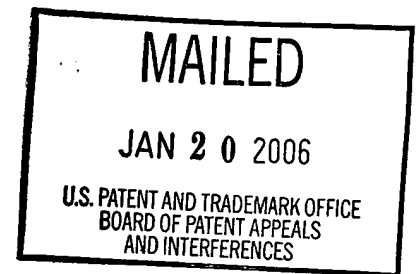
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Appeal No. 2005-1740  
Application No. 09/762,259

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ON BRIEF

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Before JERRY SMITH, BARRY and SAADAT, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-6, which constitute all the claims pending in this application.

The disclosed invention pertains to a method and apparatus for facilitating the employability of a fixed network terminal device via a specific service for a mobile network subscriber.

Representative claim 1 is reproduced as follows:

1. A method for administering a function of a service, comprising the steps of:

accepting a request for administration of said function via a mobile network terminal device of a mobile network subscriber;

identifying said mobile network subscriber;

instructing, following a successful identification, said mobile network subscriber that said service should now be informed of a connection number of a fixed network terminal device for said administration of said function;

allocating a connection number communicated after instructing said mobile network subscriber to said mobile network subscriber; and

controlling a handling of a call initiated from said fixed network terminal device via said service, said call being allocated to said mobile network subscriber with assistance of said connection number of said fixed network, dependent on a profile of said mobile network subscriber.

The examiner relies on the following reference:

Ghisler et al. (Ghisler)	5,539,807	July 23, 1996
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Claims 1-6 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Ghisler taken alone.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in the claims on appeal. Accordingly, we affirm.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to

modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision.

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Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived (see 37 CFR § 41.37(c)(1)(vii)(2004)).

In the rejection as formulated by the examiner, the examiner essentially finds that Ghisler teaches the claimed invention except that Ghisler enters the fixed terminal number initially without being prompted. The examiner takes "Official Notice" that it was well known in the art to use prompts in order to ensure that the user properly executes the procedure. The examiner finds that it would have been obvious to the artisan to prompt the user in Ghisler for a fixed number in order to ensure that the user properly executes the procedure (answer, pages 3-4).

Appellant argues that the examiner has failed to establish a prima facie case of obviousness because the examiner provides no reasoning to explain why one of ordinary skill in the art at the time of the invention would have modified Ghisler to obtain the allocating step of claim 1. Appellant disputes the examiner's assertion that the allocating step is met by the step of charging a call to a user in Ghisler. Appellant further notes the dictionary definition of "allocating" and asserts that the specification teaches that allocating means dedicating or setting

apart the terminal device for more than a single call. Based on the meaning of the terms "connection number" and "to said mobile network subscriber," appellant also argues that claim 1 must be read as defining a method where a subscriber is assigned a fixed network device identified by a connection number and where the terminal device is registered to that subscriber exclusively, thereby eliminating the requirement that the subscriber supply a PIN on subsequent calls. Finally, appellant argues that Ghisler requires that the user enter a secret code each and every time the user makes a call on the wirebound telephone, and therefore, fails to teach the connection number of claim 1 or the allocation step of claim 1 (brief, pages 8-14).

The examiner responds that Ghisler teaches use of the terminal number or connection number. The examiner notes that the argument that the claim requires allocation for more than one call fails because claim 1 does not recite this feature (answer, pages 4-5).

Appellant responds that Ghisler fails to teach the claimed allocating step because Ghisler's mobile user must re-enter a PIN each time the fixed terminal device is accessed (reply brief, page 3).

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We will sustain the examiner's rejection of claim 1. Ghisler teaches a system in which a mobile network terminal device can have calls charged to a fixed terminal device. The mobile user must provide the service with the telephone number or connection number of the fixed terminal (column 5, lines 42-43). We agree with the examiner that use of the fixed terminal in this manner constitutes a use that is distinct and separate from the normal use of the fixed terminal. In other words, this use of the fixed terminal in Ghisler meets the dictionary definition of "allocating." We also agree with the examiner that the claimed step of allocating does not require that the allocation remain in place for more than a single call. Claims are given their broadest reasonable interpretation during prosecution before the Patent and Trademark Office. Therefore, we decline to accept appellant's argument that the allocating step of claim 1 must be interpreted to require that the allocation remain in effect for more than one call. There is nothing within the dictionary definition of the term "allocating" or within its normally understood meaning that supports the interpretation proposed by appellant. We will not import appellant's specification into the claims in order to avoid the applied prior art. Appellant could easily amend the claims to require the interpretation now argued.

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With respect to independent claim 4, appellant makes the same arguments we considered above with respect to claim 1. Therefore, we sustain the rejection of independent claim 4 for the same reasons discussed above. With respect to dependent claims 2, 3, 5 and 6, appellant only asserts that these claims are allowable based on their dependency from claims 1 or 4. Since we have sustained the rejection of claims 1 and 4, we also sustain the rejection of claims 2, 3, 5 and 6.

In summary, we have sustained the examiner's rejection of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-6 is affirmed.



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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

*Jerry Smith*  
JERRY SMITH

JERRY SMITH  
Administrative Patent Judge

LANCE LEONARD BARRY  
Administrative Patent Judge

BOARD OF PATENT  
APPEALS AND  
INTERFERENCES

Mahshid D. Qadast

MAHSHID D. SAADAT  
Administrative Patent Judge

JS/hh

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NEIFELD IP LAW, P.C.  
4813-B EISENHOWER AVE.  
ALEXANDRIA, VA 22304